No. 00-201

Supreme Court, U.S.
FILED
AUG 23 2000
CLERK

IN THE

Supreme Court of the United States

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.; THE TIME INCORPORATED MAGAZINE COMPANY; LEXIS/NEXIS and UNIVERSITY MICROFILMS INTERNATIONAL,

Petitioners,

—v.—

JONATHAN TASINI; MARY KAY BLAKELY; BARBARA GARSON; MARGOT MIFFLIN; SONIA JAFFE ROBBINS and DAVID S. WHITFORD,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF FOR ADVANCE PUBLICATIONS, INC., A.H. BELO CORPORATION, BUENA VISTA MAGAZINES, INC., THE COPLEY PRESS, INC., COX NEWSPAPERS, INC., DONREY MEDIA GROUP, DOW JONES & COMPANY, INC., THE E.W. SCRIPPS COMPANY GANNETT CO., INC., HACHETTE FILIPACCHI MAGAZINES, INC., THE HEARST CORPORATION, JOURNAL COMMUNICATIONS INC., KNIGHT RIDDER, MACROMEDIA INC., MAGAZINE PUBLISHERS OF AMERICA, INC., McCLATCHY NEWSPAPERS, INC., NEWS AMERICA INC., NEWSPAPER ASSOCIATION OF AMERICA, PHILADELPHIA NEWSPAPERS, INC., PRIMEDIA INC., VILLAGE VOICE MEDIA, INC., THE WASHINGTON POST COMPANY, AND ZIFF DAVIS MEDIA INC., *AMICI CURIAE*, IN SUPPORT OF THE PETITION

Charles S. Sims
Counsel of Record
PROSKAUER ROSE LLP
1585 Broadway
New York, New York 10036
(212) 969-3950

(Additional Amici Counsel on inside cover)

Of Counsel:

JERRY S. BIRENZ, ESQ.
SABIN, BERMANT & GOULD, LLP
350 Madison Avenue
15th Floor
New York, New York 10017-3704
(212) 381-7057

Attorneys For Amici
Advance Publications, Inc.

HAROLD W. FUSON, JR., ESQ.
Vice President and
Chief Legal Officer
THE COPLEY PRESS, INC.
7776 Ivanhoe Avenue
La Jolla, California 92037
(858) 729-7633

ANDREW A. MERDEK, ESQ.
Vice President/Legal Affairs
and Corporate Secretary
COX NEWSPAPERS, INC.
1400 Lake Hearn Drive, NE
Atlanta, Georgia 30319-1464
(404) 843-5564

MARK A. HINUEBER, ESQ.
DONREY MEDIA GROUP
1111 W. Bonanza Road
Post Office Box 70
Las Vegas, Nevada 89125
(702) 477-3830

M. DENISE KUPRIONIS, ESQ.
Corporate Secretary
THE E.W. SCRIPPS COMPANY
312 Walnut Street
Cincinnati, Ohio 45202-4024
(513) 977-3000

BARBARA WARTELLE WALL, ESQ.
Vice President and
Senior Legal Counsel
GANNETT CO., INC.
1100 Wilson Blvd.
Arlington, Virginia 22234
(703) 284-6951

CATHERINE R. FLICKINGER, ESQ.
Senior Vice President
and General Counsel
HACHETTE FILIPACCHI MAGAZINES
1633 Broadway
New York, New York 10019
(212) 767-6918

ROBERT J. HAWLEY, ESQ.
Counsel
THE HEARST CORPORATION
959 Eighth Avenue
New York, New York 10019-3795
(212) 649-2075

KAREN STEVENSON, ESQ.
Vice President and
General Counsel
KNIGHT RIDDER
50 West San Fernando Street
San Jose, California 95113
(408) 938-7765

KATHERINE HATTON, ESQ.
Vice President and General Counsel
PHILADELPHIA NEWSPAPERS, INC.
400 North Broad Street
P.O. Box 8263
Philadelphia, Pennsylvania 19101
(215) 854-4710

BARBARA COHEN, ESQ.
VILLAGE VOICE MEDIA, INC.
36 Cooper Square
New York, New York 10003
(212) 475-3300

MARY ANN WERNER, ESQ.
Vice President and Counsel,
Newspaper Division
THE WASHINGTON POST CO.
1150 15th Street, NW
Washington, DC 20071-0001
(202) 334-6575

CAROLYN SCHURR LEVIN, ESQ.
Vice President and General Counsel
ZIFF-DAVIS MEDIA INC.
One Park Avenue
New York, New York 10016
(212) 503-3575

QUESTION PRESENTED

Is the publication of newspapers and magazines in digital and other non-print formats, in addition to traditional print formats, privileged under 17 U.S.C. § 201(c), or does it infringe the copyrights held by contributing freelance authors?

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

INTEREST OF THE *Amici Curiae* 1

SUMMARY OF ARGUMENT 2

ARGUMENT 4

The Court Should Grant the Petition Because the Second Circuit's Decision Rejecting the Common-Sense View that Republishing an Electronic Version of a Newspaper or Magazine Is Merely a Revision or Reprinting of a Printed Version Will Grievously and Gratuitously Disserve the Public Interest 4

CONCLUSION 10

Table of Authorities

Cases

Page

Berlin v. E.C. Publications, Inc., 329 F.2d 541 (2d Cir. 1964) 9

Harper & Row Publishers, Inc., v. Nation Enters., 471 U.S. 539 (1985) 9

Twentieth Century Music Corp. v. Aiken, 422 U.S. 151 (1975) 9

INTEREST OF THE *AMICI CURIAE*[1]

This brief *amici curiae* in support of the petition is submitted on consent by Advance Publications, Inc., A.H. Belo Corp., Buena Vista Magazines, Inc., The Copley Press, Inc., Cox Newspapers, Inc., Donrey Media Group, Dow Jones & Company, Inc., The E.W. Scripps Company, Gannett Co., Inc., Hachette Filipacchi Magazines, Inc., The Hearst Corporation, Journal Communications Inc., Knight Ridder, McClatchy Newspapers, Inc., Macromedia Inc., Magazine Publishers of America, Inc., News America Inc., Newspaper Association of America, Philadelphia Newspapers, Inc., PRIMEDIA Inc., Village Voice Media, Inc., The Washington Post Company, and Ziff Davis Media Inc. (the "*amici*"). For the reasons discussed below, *amici* urge that the Court grant the writ and hear this case on its merits.

Amici are newspaper and magazine publishers, who together publish hundreds of newspapers and magazines, including some of the most influential and useful periodicals in the nation. Many, if not all, of the *amici* have published issues of newspapers or magazines that they have made available on the NEXIS service or other databases, CD-ROMs, microfilm or electronic media, to researchers, scholars, and the general public. These issues may contain contributions from freelance contributors who have not made "an express transfer of the copyright or of any rights under it" under 17 U.S.C. § 201(c) for such electronic (or non-paper) publication. The continued availability and integrity of their publications through on-line distribution or through media such as CD-ROM therefore depends in large measure on the proper construction of 17 U.S.C. § 201(c).

---

[1] No counsel for a party authored this brief in whole or in part, and no person or entity other than the *amici curiae*, their members, or their counsel, made a monetary contribution to the preparation or submission of this brief. The individual *amici* are identified in the addendum attached hereto.

Amici have a direct and compelling interest in the right afforded them under § 201(c) to publish their publications in digital formats available online and through the Internet, and in such other media as microfilm and CD-ROM, for use by researchers, scholars and the public at large.

SUMMARY OF ARGUMENT

Amici submit this brief to focus the Court's attention on the enormous extent to which the Second Circuit's decision will restrict public access to the national historical record compiled by the nation's newspapers and magazines. With a great sense of urgency, *amici* show here that this Court's review is required, because, unless reversed, the Second Circuit's decision will harm the public interest underlying copyright law gratuitously — without any discernible benefit to the public interest underlying copyright law, or even to freelance writers in general.

Over the past two and a half decades — with the publication of back issues first on microfilm and microfiche, and then in digital form with the advent of services like NEXIS and media like CD-ROMs — back issues of newspapers and magazines have become easier to access, easier to use, and freed from physical deterioration. In reliance on these new archival media, public and university libraries have substantially reduced their holdings in physical copies of newspapers and periodicals.

The Second Circuit's decision threatens to degrade this valuable public resource immediately and severely. The boundless breadth of the decision appears, astonishingly, to mean that storage of any given issue from any given periodical with issues of other periodicals, or even with other issues of that same periodical — in a database like NEXIS, or on a CD-ROM — precludes a publisher from relying on 17 U.S.C. § 201(c) with respect to every individual article in which the publisher does not own the copyright. The decision even threatens the microfilm and microfiche archives on which the

public had come to depend (and about which freelancers had not complained) before the advent of electronic media.

As a practical matter, the Second Circuit's decision will, at a minimum, lead most publishers to delete freelance contributions from the electronic versions of their old newspapers and magazines on a wholesale basis due to the difficulty and expense of locating freelance contributors and obtaining their authorization for republication in those forms. The modest phrase "freelance contributions," moreover, covers a large territory: for newspapers, for example, it extends past such traditional "freelance" works as travel pieces and book reviews to news stories sent in by stringers, letters to the editor, Op-ed pieces, and other articles sent in "over the transom" by political officials and public spirited citizens, among others.

Whether the electronic publication occurred on NEXIS, on some other service, or in some other medium (such as optical disk or microfilm), the Second Circuit's judgment has the same consequence: it will be virtually impossible as a practical matter, and grossly inefficient, for publishers to find each and every freelance writer whose work is included in an archived edition (usually without the benefit of any delineation of who was an "employee" and whose work would therefore be work-for-hire) and to negotiate over whether and at what terms to license the retention of that contribution as an integral part of the collective work that has been archivally republished in its original or revised form.

Most publishers' continued ability to make their collective works accessible electronically with any kind of completeness and integrity depends, therefore, on this case and the Court's disposition of the petition for certiorari. If the Second Circuit's decision stands, existing comprehensive archives will not.

Unless this Court intervenes, historians, researchers, scholars, journalists, and society at large will no longer have meaningful access to the rough draft of the nation's history which back issues of the nation's newspapers and magazines represent. A generation of journalists, students and researchers

will have to re-learn the old method of traveling to a brick-and-mortar library or a newspaper morgue, if they are lucky enough to live near one that still exists and retains paper archives of the magazines and newspapers they want to review. The Second Circuit's decision does a tremendous disservice to publishers, writers, and the public without any compensating benefit. A writ of certiorari should issue, and the decision below should be reversed.

ARGUMENT

THE COURT SHOULD GRANT THE PETITION BECAUSE THE SECOND CIRCUIT'S DECISION REJECTING THE COMMON-SENSE VIEW THAT REPUBLISHING AN ELECTRONIC VERSION OF A NEWSPAPER OR MAGAZINE IS MERELY A REVISION OR REPRINTING OF A PRINTED VERSION WILL GRIEVOUSLY AND GRATUITOUSLY DISSERVE THE PUBLIC INTEREST.

1. Newspapers and magazines are written for today, but valuable for tomorrow. The economic cost of producing The Washington Post is borne by its subscribers and advertisers on any given day; but it has a continuing importance to the historians and researchers and students who examine it ten, thirty, or seventy years from its publication date. That is generally true of the works of *amici* and other periodical publishers; they write for today, but their daily, weekly or monthly editions are used in different ways by the public for years after first publication. The maintenance, completeness, integrity, and accessibility of the archive of the nation's publications is a valuable public asset.

For many years, access to the archived publications of the American press, broadly defined, depended on the work of libraries, the willingness of publications to maintain "morgues" and the ability of users to physically travel to and use those libraries and morgues. With the advent of new technologies — on-line access, whether through the NEXIS service, or the Internet, and microfilm, microfiche, and CD-ROMs — the physical library has been replaced by the electronic archive, and old issues are as a result far easier to access and to use. The historian, student, or journalist who wants to see The New

York Times of December 7, 1941, or the researcher wanting to use Time Magazine to see how the anti-war movement in the 1960s gained momentum, or the social scientist wanting to review newspapers in Iowa to see how communities in the upper Midwest reacted to the outflow of the young to the coasts in the '80s and '90s, need no longer travel to New York or Des Moines. They can access the NEXIS service, or obtain a set of CD-ROMs, and work quickly, conveniently, and efficiently. The search engines that allow users to locate individual articles within these electronic copies are simply automated and more efficient versions of the Readers' Guide to Periodicals.

2. The Second Circuit's acceptance of respondents' overly restrictive reading of section 201(c) of the Copyright Act of 1976 undermines this important function and consigns the public to paper copies of publications as the only definitive archive. That result — in an age when collection of paper archives is increasingly uncommon, when electronic storage and archiving has become standard, and in the face of the Congressional decision in 1976 to make the copyright law media-neutral — is to the practical advantage of no one, and would greatly harm the public interest. Copyright law has always protected publishers who traditionally preserved paper-printed versions of their newspapers and magazines from claims of copyright infringement by freelance writers. The Second Circuit, however, would deprive most publishers of that same protection to the extent that they choose to rely on electronic copies.

According to the Second Circuit, publishers of newspapers and magazines risk infringement liability if they publish or republish their works (containing freelance contributions) through NEXIS or comparable means, unless they first withdraw freelance articles before delivering their copy to NEXIS or comparable services or expressly acquired republication rights — even though *amici* and, the record shows, defendants, had for many years published in those additional media without complaint. Under the decision below, for example, electronic publication of law reviews, which typically

include student notes (for which written licenses expressly covering electronic rights were unlikely to have been obtained), is not privileged under § 201(c), and publishers who want to avoid liability and the NEXIS service must either purge from the published editions on NEXIS all contributions of non-employees (*i.e.*, usually the complete text of law reviews), or find and obtain consents from all past authors of student notes or of any other articles and comments for which they did not obtain appropriate express transfers. And just as pieces written by authors who cannot be located will likely be withdrawn from electronic archives, so too CD-ROMs containing back issues will likely be destroyed.

Publishing practices generally make it impractical, if not impossible, to go back and obtain authorization from freelance writers of their individually copyrighted contributions to newspapers and magazines now stored in electronic archives. Compensation for such pieces was paid when the pieces were published, and most newspapers and magazines had no need to retain records of the whereabouts of their freelance contributors. Even if records were available (which they generally are not), the chance that writers of prior decades remain at the same address is small. The impracticality of locating all freelance contributors potentially affected by the Second Circuit's opinion, much less negotiating an appropriate license, is further complicated by the possibility that fractional interests in the copyrights at issue have vested in the authors' heirs and assigns.

Nor is there any practicable way to negotiate the "appropriate" share of the publishers' revenues for the Jane Doe who wrote a piece for the travel section of The Los Angeles Times or the Bergen Record in 1981. Her article is now available on NEXIS, but because NEXIS does not collect or maintain data on whether particular articles have been downloaded or printed, no one knows if it has ever been accessed, and no one knows, or can know, what percentage of downloads or printouts by users have been for freelance work (as distinguished from staff writer work). If Jane Doe could be

found, and if she insisted on payment, it would be impossible reasonably to assess the value to her of the right to retain her work in the copy of that issue in the archive.

Consideration of the most widely used archival service, NEXIS, which does not compensate publishers for use of their archived works on a "per-hit" or "per-download" basis, illuminates the basis for concern that the likely result of the Second Circuit's judgment will likely be a decision by publishers to purge all works not written by readily identifiable staff writers, *not* any increased compensation to freelance writers for previously written works — and an over-broad purging at that, with doubts resolved *against* retaining articles of uncertain parentage (was Doe an employee or freelancer in 1981?). Because NEXIS pays publishers an annual sum for electronic republication, there is no economic benefit for publishers (or NEXIS) to retain freelance contributions in an electronic archive, but enormous risk of damage liability under 17 U.S.C. § 504 for not withdrawing content that might conceivably be owned by freelance contributors. The risk is particularly great because the Second Circuit predicated direct infringement liability based merely on the delivery of a newspaper or magazine to NEXIS (or the republication of a back issue on an optical disk or other storage medium), regardless of whether the freelance writer's work was subsequently requested, accessed, or read by anyone at all. Under the decision below, a publication infringes freelance contributions merely by duplicatively publishing a given issue on the Internet (or in some other non-print format) joined with copies of other issues or publications, even if no person has ever downloaded or printed the work of those contributors.

Given these circumstances, the impact of the Second Circuit's decision is lose-lose-lose:

- *Publishers* lose by having to allocate scarce resources to identifying and stripping freelance materials from existing databases, and lose through the diminution of the public benefit they have been making generally available.

- *Freelancers* lose, since those who would have chosen to have their works remain online without further compensation will nonetheless have their works eliminated from electronic databases, depriving them of intangible benefits of continued access and the "free publicity" it offers. That most freelancers might prefer continued inclusion in electronic databases, or on CD-ROM, etc., is of no moment: their works will still be purged, because transaction costs will prohibit most if not all publishers from pursuing the impractical task of finding and striking bargains with freelancers over contributions dating back decades, for which there is no discernible economic value.
- Most importantly, *the public* will lose its convenient access to and attendant ability to search through comprehensive and genuine archived newspapers and magazines.

Moreover, the decision below would likely make matters *worse* than they were before the advent of electronic media. During the past few decades, as a result of the availability of services like NEXIS, and new storage media like CD-ROMs, many libraries have cleared their shelves of their paper-printed archives of periodicals and reduced their ongoing archival efforts. Storage costs and the fragility of newsprint have spurred increasing reliance on electronic archives, whose accessibility and permanence have been enormously beneficial. The Second Circuit opinion therefore threatens not only the integrity of the historical record, but as a matter of practical fact, the accessibility to the historical record too.

Nor is it any answer to say that the decision below only affects New York, and that the Court should wait to see if conflict develops before granting review. Because New York is the center of the magazine publishing and advertising industries, and most publishers are arguably subject to suit in New York, the Second Circuit's judgment effectively establishes a national rule for newspaper and magazine publish-

ers (and their existing electronic publications) throughout the nation, which do not have the luxury of waiting to see whether other circuits, including those where their principal offices may be located, reach different conclusions.

The increasing accessibility of back issues in new media has undeniably advanced copyright's goal of increasing the store and availability of writing. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (aim of copyright law is "promoting broad public availability of literature, music, and the other arts"). Historians, researchers of various types, students, and curious citizens are able as never before to access back issues, not just of their own home town papers, but of a wide range of newspapers and magazines throughout the nation. The Second Circuit's decision would destroy that achievement, and turn a comprehensive, accurate, national archive into a collection of local ones, riddled with holes. Publishers who strive for completeness and a faithful electronic record could be exposed to any holdout's whims, giving individual freelancers bargaining power out of all proportion to any real value in any individual work that may have no real public demand at all. The resulting "hole in history" would have a devastating impact on research and study.

If, as the Second Circuit has held, delivery of copies of newspapers and magazines containing freelance contributions to NEXIS (or to other services or archival media) infringes the rights of freelance contributors, then existing archives will likely be perforated, because the contributors cannot as a practical or economic matter be located, and because the risk from not deleting conceivably "infringing" articles far exceeds any economic benefits to publishers of retention. The value of existing complete electronic archives will be sacrificed to the Second Circuit's misreading of § 201(c).

Publishers should not be forced to degrade their public archives without this Court's careful review, which *amici* believe would lead to a far different result than that woodenly reached below. As this Court has repeatedly emphasized, the touchstone of copyright law is copyright law's overarching

purpose "to increase and not to impede the harvest of knowledge." *Harper & Row Publishers, Inc., v. Nation Enters.*, 471 U.S. 539, 545 (1985); *see also Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 543 (2d Cir. 1964) ("particular claims of infringement must occasionally subordinate the copyright holder's interest in a maximum financial return to the greater public interest in the development of art, science and industry").

Amici respectfully submit that the Second Circuit's decision retroactively allocating to freelancers rights for works previously created cannot be squared with copyright's purpose of "increas[ing] . . . the harvest of knowledge." The potential license fees were not necessary to induce creation of those works, and are so small, for any given work, that they cannot plausibly be said to have induced that or any further creation. But the liability ruling below will surely shrink the harvest of existing knowledge by making the complete historical archive inaccessible in any medium but print, if it exists at all.

CONCLUSION

Because the Second Circuit's decision threatens vital public interest in access to the complete national historical record as reported by the nation's newspapers and magazines and made available through such services as NEXIS or such electronic media as CD-ROMs and microfilm, the petition for a writ of certiorari should be granted.

Respectfully submitted.

Charles S. Sims
Proskauer Rose LLP
1585 Broadway
New York, NY 10036
(212) 969-3950
Counsel of Record